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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)
1633

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on February 17, 2006

Signature Lawrence H. Aaronson

Typed or printed name Lawrence H. Aaronson

Application Number	Filed
09/976,801	October 12, 2001

First Named Inventor
Michael T. Lundy

Art Unit	Examiner
3627	Andrew J. Rudy

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).
Note: No more than five (5) pages may be provided.

I am the

☐ applicant/inventor.

☐ assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

☒ attorney or agent of record.
Registration number 35,818

☐ attorney or agent acting under 37 CFR 1.34.
Registration number if acting under 37 CFR 1.34 _____

Lawrence H. Aaronson
Signature

Lawrence H. Aaronson
Typed or printed name

312 913-2141
Telephone number

February 17, 2006
Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☐ *Total of _____ forms are submitted.

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
(Sprint Docket No. 1633)

In re Application of:	)	
	)	
Michael T. Lundy	)	**Art Unit: 3627**
	)	
Serial No.: 09/976,801	)	**Examiner: Andrew J. Rudy**
	)	
Filed: October 12, 2001	)	**Conf. No. 3983**
	)	
For: ASYNCHRONOUS USER AUTHORIZED ADVERTISING	)	

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Commissioner for Patents
P.O. Box 1450
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REASONS FOR REVIEW OF FINAL REJECTION

Applicant requests review of the final rejection mailed November 21, 2005, because the Examiner has not set forth a sufficient basis for rejecting any of the claims. In particular, the Examiner has not pointed to any teachings in the art that disclose or suggest the combination of elements recited in Applicant's claims. Thus, the Examiner has not made out the requisite *prima facie* case of obviousness under M.P.E.P. § 2143.

1. The Claimed Invention

Presently pending are claims 1-13 and 30-32, of which claims 1, 6, 10, and 12 are independent. These claims are all directed to a method for advertising on a subscriber terminal.

As recited in claim 1, an advertising authorization request is sent to the subscriber terminal via an electronic communications network. Then, a reply to the authorization request is received from the subscriber terminal, the reply including an authorization for an advertisement

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to be sent to the subscriber terminal. Given the authorization, the advertisement is then sent to the subscriber terminal when a triggering event occurs.

Claims 6 and 12 similarly include the authorization request and/or reply and also recite displaying the advertisement on the subscriber terminal when at least one triggering event occurs. And claim 10 similarly includes the authorization request and reply and sending the advertisement to the subscriber terminal when at least one triggering event occurs.

Dependent claims 2, 7, and 11 further define the triggering event as either the subscriber terminal being idle or the subscriber terminal being substantially stationary. And dependent claims 5 and 9 further limit the method by defining the triggering event as the subscriber terminal being *both* idle *and* substantially stationary.

2. Clear Error by the Examiner

In the final office action, the Examiner rejected all of the claims as being allegedly obvious over U.S. Patent No. 6,892,354 (Servan-Schreiber) in view of the fact that "triggering events are common knowledge in the telecommunication art, as are stationary subscriber terminals." This rejection is clearly erroneous, because Servan-Schreiber fails to disclose or suggest anything about receiving or replying to an advertising authorization request as recited in Applicant's claims, and because the general concepts of "triggering events" and "stationary subscriber terminals" do not make up for that basic deficiency of Servan-Schreiber.

Servan-Schreiber is directed to a method of downloading advertisements to a computer when the computer is idle. In particular, Servan-Schreiber teaches that, after content has been downloaded to a computer, the computer will then background-download an advertisement, which the computer can then display to a user when waiting for a next content download to complete.

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The fact that Servan-Schreiber discloses a computer downloading an advertisement does not amount to, or suggest, Applicant's claimed invention. At a minimum, it does not suggest providing an ***advertising authorization request*** or receiving (or retrieving) a ***reply to an advertising authorization request*** as recited in Applicant's claims. The closest it comes to this is teaching that the computer downloads an advertisement, typically by sending a request (perhaps an HTTP request) to a remote server and receiving the advertisement in response. (See, e.g., column 3, lines 6-15). However, the act of a subscriber terminal requesting an advertisement and receiving the advertisement in response does not constitute the advertising authorization request functionality recited in Applicant's claims.

In this regard, claims 1 and 6 make clear that the advertising authorization request and reply occur ***before*** sending an advertisement to a subscriber terminal, as the claims recite that the advertisement is sent in response to the authorization (or in response to the reply). Further claims 1 and 6 recite that ***the advertising authorization request is sent to the subscriber terminal*** and that the ***reply to that request is received from the subscriber terminal***. In Servan-Schreiber, the only advertising-related request that precedes sending of the advertisement to the subscriber terminal is a request *from the computer to the server*, seeking the advertisement. However, this request cannot be the "advertising authorization request" of Applicant's claims, because it is not a request *to the subscriber terminal* (and because it is not seeking authorization of any kind). Further, the resulting transmission of an advertisement from the server to the subscriber terminal cannot then be the "reply" of Applicant's claims, because the transmission of the advertisement is not a transmission *from the subscriber terminal* (and because it is not a reply to an authorization request of any kind). Thus, Servan-Schreiber fails to suggest the invention of claims 1 and 6.

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Claims 10 and 12 recite the function of retrieving a reply to an advertising authorization request, where the reply authorizes at least one advertisement to be sent to a subscriber terminal. In Servan-Schreiber, there is no teaching of an advertising authorization request, and thus there is no teaching of a reply to such a request. Servan-Schreiber's teaching of sending a request for an advertisement from a computer to a server cannot be the "advertising authorization request" of Applicant's claims, because it is not a request seeking authorization of any kind. Further, Servan-Schreiber's teaching of responsively sending an advertisement from the server to the subscriber terminal cannot be the "reply" of Applicant's claims, because it is not a reply to an authorization request of any kind and particularly because it is not a reply that authorizes at least one advertisement to be sent to the subscriber terminal. Thus, Servan-Schreiber fails to suggest the invention of claims 10 and 12.

In rejecting the claims, the Examiner noted that Servan-Schreiber does not disclose the triggering event but asserted that triggering events are generally well known. (Similarly, the Examiner focused on just this point in the advisory action mailed February 2, 2006.) With all due respect, the Examiner's focus on the triggering events seems to disregard the more basic failure of Servan-Schreiber to teach anything about an advertising authorization request. Further, the Examiner has not pointed to any objective evidence that would suggest modifying Servan-Schreiber in order to achieve the claimed advertising authorization request functionality or to include the triggering event functionality in that context. Thus, the Examiner has not made out the requisite *prima facie* case of obviousness of Applicant's claims.

3. Conclusion

Because the Examiner has not pointed to any objective evidence in the art that suggests the presently claimed invention, the Examiner has clearly erred in rejecting the claims under 35

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U.S.C. § 103. Therefore, Applicant submits that the rejections should be withdrawn and all of the claims should be allowed.

Respectfully submitted,

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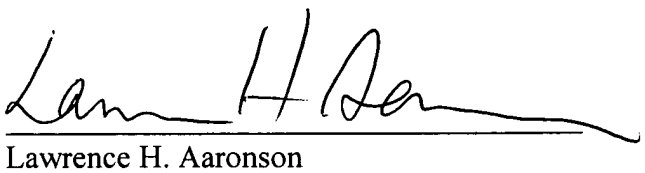
Date: February 17, 2006

By: 

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